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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,183	01/26/1999	NORDINE CHEIKH	16517.228	9529

28381 7590 04/16/2003

ARNOLD & PORTER  
IP DOCKETING DEPARTMENT; RM 1126(b)  
555 12TH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

29

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/237,183

Applicant(s)  
Cheikh et al.

Examiner  
Ardin Marschel

Art Unit  
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 16, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 7-27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 7-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

The request, filed 12/16/02, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/237,183 is acceptable and a CPA has been established. An action on the CPA follows.

Applicants' arguments, filed 12/16/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### VAGUENESS AND INDEFINITENESS

Claims 2, 26, and 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 cites a series of SEQ ID NOS. as well as a selection of enzyme names. Two possible confusing interpretations may be applied to these separate listings in claim 2. One interpretation is that any of the specific SEQ ID NOS. may describe a nucleic acid which encodes any of the listed enzymes. This is confusing as sequences are well known in the art to encode particular biomolecules, such as enzymes as in this situation. Thus, a claim directed to a nucleic acid molecule which may be interpreted as encoding a variety of enzymes is

confusing when these nucleic acids are apparently too short to encode multiple enzymes. It is noted that SEQ ID NO: 11, for example, is only 256 nucleotides long which is also unlikely to be enough length even for one enzyme coding region. Another possible interpretation is that there is a one to one correspondence between the SEQ ID NOS. and the enzyme coding region that they contain. This, however, is not clearly and concisely set forth in the claim and thus even this interpretation is vague and indefinite. Clarification via clearer claim wording is requested.

Abbreviations in claims 2, 26, and 27 result in the claims being vague and indefinite unless the abbreviations are accompanied by a full name. It is noted that claims 2 etc. contain abbreviations such as NDP and UDP. Clarification via clearer claim wording is requested.

#### LACK OF UTILITY REJECTION

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject

matter claimed. This contrasts with a general utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 2 and 7-27 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by either specific and/or substantial utility or

a well established utility.

This rejection is maintained and reiterated from the previous office action, mailed 7/16/02. Applicants have not submitted any arguments regarding this rejection and it is therefore maintained, as set forth previously, as well as applied against newly added claims which are directed to specific species within the previously pending claims

#### LACK OF ENABLEMENT REJECTION

Claims 2 and 7-27 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention. This rejection is reiterated and maintained from the previous office action, mailed 7/16/02. Applicants have not submitted any arguments regarding this rejection and it is therefore maintained, as set forth previously, as well as applied against newly added claims which are directed to specific species within the previously pending claims

#### LACK OF WRITTEN DESCRIPTION REJECTION

Claims 2 and 7-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

This lack of written description rejection is maintained and reiterated from the previous office action, mailed 7/16/02. Applicants have not submitted any arguments regarding this rejection and it is therefore maintained, as set forth previously, as well as applied against newly added claims which are directed to specific species within the previously pending claims

#### INFORMALITIES

The disclosure is objected to because it contains an embedded hyperlink and/or other form or browser-executable code. Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Such code is present in the specification at page 19, lines 10-17, and elsewhere. It is noted that applicants have reduced the code but, unfortunately not enough. An attempt to utilize the remaining hyperlinks by the Examiner's computer resulted in these hyperlinks still being usable and interpretable as such. Therefore, further deletion is required in order to satisfy this correction requirement. This objection is still maintained as applicants have not responded to the basis for this objection which is that the remaining hyperlinks in the specification still remain fully functional as hyperlinks as noted above. Applicants' allegation that they are not is contrary to the

factual situation. Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

April 16, 2003

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER